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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,337	09/16/2003	Keiko Shiraishi	117194	9255
25944 7590 12/23/2010 OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850				
EXAMINER				
PATEL, MANGLESH M				
ART UNIT		PAPER NUMBER		
2178				
NOTIFICATION DATE		DELIVERY MODE		
12/23/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

OfficeAction25944@oliff.com  
jarnstrong@oliff.com

### Office Action Summary

**Application No.**

10/662,337

**Applicant(s)**

SHIRAIISHI ET AL.

**Examiner**

MANGLESH M. PATEL

**Art Unit**

2178

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 April 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11 and 17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-912)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 4/16/2010
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This **Non-Final** action is responsive to the RCE and IDS filed on 4/16/2010.
2. In the Continuation claims 11 and 17 remain pending. Claims 1-10 and 12-16 have been canceled. Claims 11 and 17 are the independent claims.

### **Withdrawn Rejections**

3. The 35 U.S.C. 103(a) rejections of claims 1-17 with cited reference of Lee (U.S. 6,782,379) in view of Shore (U.S. 6,564,193) has been withdrawn in light of the amendment.

### **Information Disclosure Statement**

4. The information disclosure statement (IDS) submitted on 4/16/2010 has been entered, and considered by the examiner.

### **Claim Rejections - 35 USC § 112**

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
6. **Claims 11 and 17 are rejected under 35 U.S.C. 112**, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention. The claims describes an execution part that reads the portable storage medium to access the instruction form, however the claim also states that the same “at least one instruction form is located on at least one server”. The claim is vague regarding the storage of the instruction form, either in a portable storage medium, or at a server or both.

### **Claim Rejections - 35 USC § 103**

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 11 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kadowaki (U.S. 6,674,537, filed on Jun.15, 1998 and previously cited in the action dated 7/14/2006) in view of Kim (U.S. 7,542,157, filed on Feb. 27, 2003).

**Regarding Independent claims 11 and 17,** An instruction form execution apparatus comprising: an attachment part that attaches a portable storage , medium which is unique to and capable of being carried by a predetermined user, the storage medium holding information on a plurality of instruction form management apparatuses holding at least one selectable instruction form associated with the user based on user access rights, wherein the instruction form is generated in advance, wherein the instruction form including tags for at least one of scanning, printing, or faxing instructions and indicates a

plurality of processing to be executed by a plurality of instruction form execution apparatuses and is different than any file to be processed by the instructions; and an execution part that, when the portable storage medium is attached to the instruction form execution apparatus, reads the instruction form having user access rights from the portable storage medium, and executes a plurality of processing instructions indicated in the instruction form, wherein the at least one selectable instruction form is located on at least one server.

Kadowaki discloses an attachment part an ID Card that is a portable storage medium being unique and carried by a user (see abstract). The storage medium holds information on a plurality of instruction form management apparatuses such as copying machine, facsimile device and printers (see fig 1 & column 7, lines 40-67). The portable device includes individual setting information for the devices, this setting information is representative of the at least one instruction form and is generated in advance as stored in the ID card (column 18, lines 5-65). Kadowaki also discloses connecting this attachment part to the device based on the user access rights from the card and then selecting a plurality of processing instructions as indicated from the setting information see figs 16 & 25. Kadowaki doesn't explicitly teach that the setting information comprises tags for printing scanning or faxing. Kim discloses setup command data defined in a markup language such as XML and sent to a printer for executing a plurality of processes thereby suggesting tag data for printing (see abstract & column 2, lines 1-33 & column 5, lines 25-60). At the time of the invention it would have been obvious for one of ordinary skill

in the art to have modified the system of Kadowaki to include storage of setting information in a markup format on an ID card. The motivation for doing so would have been to provide a standardized format for communicating with a plurality of execution apparatuses using a single portable device, thereby saving a user time.

**It is noted that any citation [[s]] to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. [[See, MPEP 2123]]**

#### **Response to Arguments**

9. Applicant's arguments filed 4/16/2010 have been fully considered but are moot in view of the new grounds of rejection.

:

#### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manglesh M. Patel whose telephone number is (571) 272-5937. The examiner can normally be reached on M, W 6 am-3 pm T, TH 6 am-2pm, Fr 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Manglesh M. Patel  
Patent Examiner (AU 2178)  
December 16, 2010

/Manglesh M Patel/  
Manglesh Patel  
Examiner, Art Unit 2178

/Stephen S. Hong/  
Supervisory Patent Examiner, Art Unit 2178